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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
07/519,497	05/04/90	HOLSINGER	S 20809

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EXAMINER
GARLAND,S

ART UNIT	PAPER NUMBER
235	3

DATE MAILED: 11/01/90

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 10/15/90 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 3 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |   |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input checked="" type="checkbox"/> Notice re Patent Drawing, PTO-948.       |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.      | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474.     | 6. <input type="checkbox"/>   |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-15 are pending in the application.  
Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☒ Claims 1-15 are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under U.S.C. 119: The certified copy has ☐ been received ☐ not been received  
☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

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1. Claims 1-15 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following are given as examples.

Claim 1, line 21, it is unclear which selected time is being added, since the latch can store more than one time. Also in lines 43-46, insufficient structure and/or interconnections are set forth to allow the sector location pulse generation means to perform its desired function.

Claim 4, line 3, "the controller pulses" lacks an antecedent basis.

In claim 9, it is unclear as to what the accumulating step actually does i.e. what time or times are being accumulated. In line 15, "the accumulated time" and in lines 20-21 "the accumulation of next sector times" lacks a clear antecedent basis.

In claim 10, line 17, "the index mark" lacks an antecedent basis.

The other claims have problems similar to the examples given above.

2. Claims 2, 7, 9, 10, 13, and 15 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 2, 3, and 5-8 of copending application Serial No.

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07/445,753. This is a *provisional* double patenting rejection since the conflicting claims have not in fact been patented.

For example compare claim 2 of this application to claim 3 of the parent application 07/445,753.

3. Claims 1 and 6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4 of copending application Serial No. 07/445,753. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are virtually identical. The more detailed recitations of the claims in the parent application 07/445,753 obviously include the broader recitations of the claims of this application.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dennison et al. and Yoshimaru are of interest in using

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different numbers<sup>of</sup><sub>A</sub> sectors on different areas of a disk. Both are also of interest in providing sector pulses, index pulses, counting sector pulses, etc.

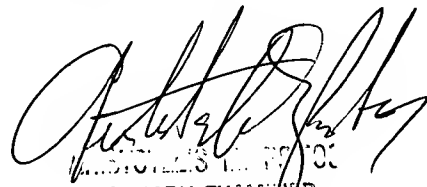
6. Claims 3-5, 8, 11, 12 and 14 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 and to include all of the limitations of the base claim and any intervening claims.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Garland whose telephone number is (703) 308-1762.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0754.

SRG

STEVEN GARLAND

  
STEVEN GARLAND  
PATENT EXAMINER  
ART UNIT 235

SG/MS  
October 26, 1990